

REMARKS

It is respectfully requested that this application be reconsidered in view of the above amendments and the following remarks and that all of the claims remaining be allowed.

Claim Amendments

Claim 63 has been amended to recite a method for preparing an antibody or a fragment thereof that comprises the antigen binding site of the antibody, as well as a step of "raising" an antibody. Support for these recitations can be found, for example, at page 21, lines 36-38.

Claim 63 has further been amended to recite determining and confirming the specificity of the raised antibody. Support for this recitation can be found, for example, at page 16, lines 11-23, as well as general knowledge in the art.

Claims 64, 65 and 70-72 have been amended to recite "antibody or fragment" instead of "binding compound", for which support can be found, for example, at page 5, lines 15-33 and page 22, lines 3-5.

Claim 69 has been rewritten to recite obtaining an antibody or fragment with a desired specificity by providing candidate antibodies or fragments and selecting the desired antibody or fragment from the candidates. No new matter has been introduced.

New claims 74-79 have been added. Support for these new claims can be found, for example, as follows:

Claim Number	Exemplary Support
74	page 21, line 36 to page 22, line 12, as well as general knowledge in the art
75	Page 22, lines 3-8; page 23, lines 13-14; and original claim 15
76	Page 22, line 15
77	Page 5, line 26

Claim Number	Exemplary Support
78	Page 43, lines 1-4
79	Page 5, line 26

No new matter has been added by these amendments. The Examiner is hereby requested to enter these amendments.

Applicants submit that all claim amendments presented herein or previously are made solely in the interest of expediting allowance of the claims and should not be interpreted as acquiescence to any rejections or ground of unpatentability. Applicants reserve the right to file at least one continuing application to pursue any subject matter that is canceled or removed from prosecution due to the amendments.

Rejections Under 35 U.S.C. §112

The rejection of claims 63-73 under 35 U.S.C. §112, second paragraph, is respectfully traversed for the reasons set forth below.

The Office Action states that the claims are allegedly incomplete for omitting essential steps under MPEP §2172.01. Specifically, the Office Action alleges that claim 63 is drawn to preparing a binding compound, but no antibodies are made by the claimed method.

As amended, claim 63 recites a method for preparing an antibody or a fragment thereof that comprises the antigen binding site of the antibody. Furthermore, claim 63 comprises a step of "raising an antibody". Thus, it is clear that antibodies are made in the claimed method.

The Office Action also alleges that claim 69 is directed to a "method of preparing a binding compound" while comprising only a single step of selecting the binding compound. Since claim 69 has been amended to recite a method of "selecting" an antibody or fragment, this rejection is now moot.

Applicant : Oppmann, et al.
Serial No. : 09/658,699
Filed : September 8, 2000
Page : 8 of 8

Attorney's Docket No.: 16622-005001 / DX01042X

Accordingly, withdrawal of the rejection is respectfully requested.

Conclusions

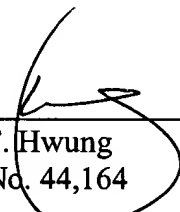
For the reasons set forth above, Applicants submit that the claims of this application are patentable. Reconsideration and withdrawal of the Examiner's objections and rejections are hereby requested. Allowance of the claims remaining in this application is earnestly solicited.

In the event that a telephone conversation could expedite the prosecution of this application, the Examiner is requested to call the undersigned at (650) 839-5044.

Enclosed is a \$110.00 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: Aug. 9, 2004



Ping F. Hwung
Reg. No. 44,164

Fish & Richardson P.C.
500 Arguello Street, Suite 500
Redwood City, California 94063
Telephone: (650) 839-5070
Facsimile: (650) 839-5071